

## **REMARKS**

### **Formal Matters**

Claims 128-137 and 145-151 are pending after entry of the amendments set forth herein.

Claims 128-137 and 145-151 were examined. Claims 128-137 and 145-151 were rejected.

Applicants respectfully request reconsideration of the application in view of the amendments and remarks made herein.

No new matter has been added.

### **The Office Action**

#### **Claims Rejected Under 35 U.S.C. Section 103(a) (Taylor et al.)**

In the Official Action of June 7, 2010, claims 128-133, 145 and 147-149 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Taylor et al., U.S. Patent No. 6,036,641.

Regarding claim 128, the Examiner admitted that the embodiment of Fig. 9A of Taylor et al. does not form a continuous loop but asserted that it would have been obvious to make it in the shape of a continuous loop because the embodiment of Fig. 7B and 8 each show a continuous loop. Applicants disagree and respectfully submit that it does not logically follow that a disclosure of one embodiment of an invention having a continuous loop is teaching for providing another distinct embodiment, which does not have a continuous loop, to have a continuous loop. It is respectfully submitted that the motivation for the Examiner's suggestion was derived from an improper hindsight, based on reading the present claims and specification.

The Examiner further asserted that the bottom surface of the side portions of the embodiment of Fig. 7B of Taylor et al. decline angularly from outer peripheral portions thereof. Applicants respectfully traverse. It is respectfully submitted that the angles pointed out by the Examiner in Fig. 7B on page 3 of the Office Action are in the direction along the length of the side portions. Not in a direction from an outer periphery of the side portion to the inner periphery of the side portion. Rather, the side portions are flat, as can be observed by the major portions pointed to by reference numerals 1 in Fig. 7B. The angled portions are at the ends of the side portions, but they do not angle from the outer periphery toward the

inner periphery. To clarify this distinction, Applicants have amended claim 128 above to note that the inner portions abut the opening around which the continuous loop is formed, and that the declination is from the outer peripheral portions of the side portions to the inner peripheral portions thereof. Support for this amendment can be found, for example, at Figs. 16A-16B and the descriptions thereof. It is respectfully submitted that the side portions of Taylor et al., Fig. 7B lack these features, as the surfaces are flat, not declining or inclining in the direction from the outer periphery of the side portion to the inner periphery thereof.

The Examiner further asserted that the recitations “adapted to be placed on the tissue in an area bounded by primary tissue contact members” and “such that the outer peripheral portions of the contact surface of said side portions are configured to contact the primary stabilization member while the inner peripheral portions of the contact surface of said side portions contact the tissue to provide additional stabilization of the tissue” are functional claim language or intended uses, and therefore that if the prior art structure is capable of performing the recited functions or intended uses, then it meets the claim. The Examiner concluded that Taylor et al. shows the contact member of Fig. 9A in combination with the contact member of Fig. 7B are capable of performing said claimed functional limitations.

Applicants respectfully traverse. It is respectfully submitted that the side contact surfaces of Fig. 7B of Taylor et al. are flat, in the transverse direction (outer periphery to inner periphery) as noted above, and that Fig. 9A also fails to disclose declining side surfaces as claimed. Accordingly, if the outer peripheral portions of the side contact surfaces of the elongated side members 1 were placed in contact with a primary stabilization member as claimed, the inner peripheral portions of the side contact surfaces of the elongated side members 1 would not contact the tissue, but would be spaced above the surface of the tissue. This is because the primary stabilization member has a thickness and the contact members of the elongated side members 1 do not decline downwardly from the outer peripheral portions to the inner peripheral portions. Thus, the inner peripheral portions would be at the same height as the outer peripheral portions contacting the primary stabilization member, i.e., spaced above and out of contact with the tissue surface. Therefore, it is respectfully submitted that the prior art in this case is not capable of performing the recited functions or intended uses.

As to claims 130-131, the Examiner has asserted that it would have been an obvious design choice to make the contact member of Taylor et al. substantially oval-shaped. However, the Examiner has not provided any reference which teaches or provides motivation for such a modification. Applicants respectfully submit that the shape facilitates the function of the device to provide additional stabilization, in addition to that provided by a primary stabilization member. On the other hand, each of

the embodiments of Taylor et al. referred to by the Examiner are primary stabilization devices.

Accordingly, it is respectfully submitted that it would not have been obvious to modify the devices of Taylor et al. in the manner asserted by the Examiner, as there is no motivation to modify them to function as devices for providing additional stabilization.

The Examiner referred to M.P.E. P. 2144.04 as justification for asserting that the oval-shape would have been an obvious design choice. However, this portion of the M.P.E.P relates to aesthetic design changes relating to ornamentation only which have no mechanical function. However, Applicants have already previously noted that the claimed oval shape does have a function, specifically that of facilitating the function of the device to provide additional stabilization, in addition to that provided by a primary stabilization member. As the oval function facilitates the interaction against the primary stabilization member. The Examiner has not responded to this argument, but has merely repeated the conclusion regarding obvious design choice. Accordingly, it is respectfully submitted that the Examiner has failed to set forth a prima facie case of obviousness in this regard.

Claim 145 has been amended to clarify that inner portion of the contact member interfaces with said central opening. Support for this amendment can be found, for example, at Figs. 16A-16B and the descriptions thereof.

It is respectfully submitted that Taylor et al. does not disclose, teach or suggest canted bottom surfaces of the side portions as claimed, for reasons already articulated above.

Claim 147 has been amended to clarify that the inner perimeter portion of said bottom contact surface interfaces with said central opening. Support for this amendment can be found, for example, at Figs. 16A-16B and the descriptions thereof.

It is respectfully submitted that Taylor et al. does not disclose, teach or suggest an outer perimeter portion along elongated sides that is configured to contact a primary stabilization member while an inner perimeter portion of the elongated sides contacts the tissue to provide additional stabilization of the tissue, for reasons already articulated above, since the embodiments of Taylor et al. are incapable of performing this function.

Claim 148 has been amended to clarify that said interior bottom portions along said elongated sides interface with said opening and said elongated sides are canted such that said exterior bottom portions along said sides are higher than corresponding interior bottom portions along said sides. Support for this amendment can be found, for example, at Figs. 16A-16B and the descriptions thereof. It is respectfully submitted that Taylor et al. fails to disclose, teach or suggest these features for reasons already noted above.

Claim 149 has been amended to clarify that said elongated portions of said contact bottom surface cant upwardly in opposite directions on opposite sides of said central opening, from an interior portion thereof to an outer perimeter thereof. Support for this amendment can be found, for example, at Figs. 16A-16B and the descriptions thereof. It is respectfully submitted that Taylor et al. fails to disclose, teach or suggest these features for reasons already noted above.

In view of the above amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 128-133, 145 and 147-149 under 35 U.S.C. Section 103(a) as being unpatentable over Taylor et al., U.S. Patent No. 6,036,641., as being inappropriate.

**Claims Rejected Under 35 U.S.C. Section 103(a) (Taylor et al. in view of Borst et al.)**

Claims 134-137, 146 and 150-151 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Taylor et al., U.S. Patent No. 6,036,641 in view of Borst et al., U.S. Patent No. 5,836,311. The Examiner asserted that Taylor et al. discloses the invention substantially as claimed. For at least the reasons mentioned above under the grounds of rejection of claims 128-133, 145 and 147-149, Applicants respectfully traverse.

The Examiner further asserted that Taylor et al. discloses openings 47 being fluidly connected with a substantially hollow interior (lumen 48) and capable of applying a negative pressure to the tissue. The Examiner referenced column 17, lines 30-42 of Taylor et al. as support for these assertions.

Applicants respectfully traverse. Taylor et al. disclose at column 17, lines 40-41, that the ports 47 are disposed in the top surface of the contact members 1. Thus, ports 47 function as a blower, or alternatively, to suction fluids away from the site of the anastomosis.

The Examiner asserted that it would have been obvious to modify the device of Taylor et al. to place the suction ports 47 at the bottom surface in order to provide a suction mechanism that sucks onto or seals with tissue, providing a more effective stabilization of the heart, as taught by Borst et al.

Applicants respectfully traverse. It is respectfully submitted that the device in Fig. 9A of Taylor et al. functions to both stabilize the surgical target area, as well as to keep it clear (visually) by blowing or suctioning fluids away from the surgical target area. Thus, if the device of Fig. 9A of Taylor et al. were modified to place the suction ports 47 in the bottom surfaces of the contact members, as suggested by the Examiner, this would destroy the function of the device for clearing the surgical site by blowing or suctioning. Accordingly, it is respectfully submitted that the proposed combination would not have been obvious as it would destroy a stated function of Taylor et al. Accordingly, it is respectfully

submitted that the Examiner has not set forth a prima facie case of obviousness in this regard.

Regarding claims 135-137, the Examiner asserted that Borst et al. teaches two separate independent suction sources at column 7, lines 29-34. The Examiner asserted that it would have been obvious to provide Taylor et al with two separate independent suction sources for that if one suction source were to lose contact with tissue, the other could still maintain capture.

Applicants respectfully traverse. It is respectfully submitted that none of the suction ports 47 of Taylor et al. are disclosed as contacting the tissue. Accordingly, it is respectfully submitted that the Examiner's reasoning for modifying Taylor et al. is not applicable, because the ports 47 do not contact the tissue. Further, as already note above, it is respectfully submitted that it would not have been obvious to modify Taylor et al. to move the ports 47 to the bottom surfaces of the contact members, since this would destroy the function of the device for clearing the surgical site by blowing or suctioning.

The Examiner further argued that it would have been obvious to provide one negative suction source for adhering the contact member to the tissue, while the other could be used for maintaining the surgical site clear and dry. Applicants respectfully submit that neither reference, whether taken alone or in any proper combination provides any teaching or suggestion to support the Examiner's conclusion. It is respectfully submitted that the Examiner's conclusion is only from improper hindsight reasoning gained from a reading of the present specification and claims.

It is further noted that, like Taylor et al., Borst et al. also fails to disclose or suggest a device for providing additional stabilization to tissue already in contact with a primary stabilization member and fails to disclose canted contact surfaces that are angled in opposite directions on opposite sides of a central opening, and there would therefore have been no motivation or teaching to modify Taylor et al. to include a contact surface as claimed.

Claim 150 has been amended to clarify that said bottom surface is inclined upwardly, along a continuous slope, in opposite directions on opposite sides of said central opening, along a direction from an interior perimeter thereof to an exterior perimeter thereof, over lengths of said side portions, in a direction transverse to a direction of said length of said side portions of said loop. Support for this amendment can be found, for example, at Figs. 16A-16B and the descriptions thereof.

It is respectfully submitted that none of the embodiments of Figs. 4B, 7B and 9A of Taylor et al., nor any of the embodiments of Borst et al., or any proper combination of these references have a contact bottom surface as claimed.

In view of the above amendments and remarks, the Examiner is respectfully requested to

reconsider and withdraw the rejection of claims 134-137, 146 and 150-151 under 35 U.S.C. Section 103(a) as being unpatentable over Taylor et al., U.S. Patent No. 6,036,641 in view of Borst et al., U.S. Patent No. 5,836,311, as being inappropriate.

### **Conclusion**

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-2653, order number GUID-021DIV.

Respectfully submitted,  
LAW OFFICE OF ALAN W. CANNON

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By: /Alan W. Cannon/  
Alan W. Cannon  
Registration No. 34,977

LAW OFFICE OF ALAN W. CANNON  
942 Mesa Oak Court  
Sunnyvale, CA 94086  
Telephone: (408) 736-3554  
Facsimile: (408) 736-3564